

**REMARKS/ARGUMENTS**

For the reasons set forth below, Applicant respectfully requests reconsideration of the final rejection of Claims 34-37, 42, 47, 55 and 56.

1. Claims 34-37 and 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,483,501 ("Eddy") in view of U.S. Patent No. 5,680,660 ("Johanknecht"). Such rejection is respectfully traversed.

Eddy fails to disclose at least two prominent features of the invention prescribed in independent Claim 34, the first of which is common to all of Applicant's claims. Specifically, Eddy is silent as to "means for connecting said receptacle to said free portion whereby a user of the caddy can orient said open end of said receptacle upwardly regardless of whether said free portion extends upwardly or downwardly with respect to said captured portion."

In stark contrast, the free portion 14 of the Eddy device can never extend upwardly with respect to the captured portion 12. Panels 12 and 14 are joined by an integral reduced thickness zone 16 which defines a "living hinge." See Eddy at column 2, lines 24-27. Column 3, lines 9-16 expands upon the structure of "living hinge" 16 (emphasis added):

Other than the short bar 22 and the fasteners 24, the holster 10 is constructed of a single piece of plastic material suitable for forming the "living hinge" along the zone 16. The zones 34 may be defined in the first panel 12 by forming a plurality of grooves in the

panel 12 on only one side thereof while the zone 16 may be formed by forming registered grooves in opposite sides of the panel 12.

In view of these passages and the attendant drawing figures of Eddy, it is clear that the free portion 14 of the Eddy device simply cannot extend upwardly with respect to the captured portion 12. A handgun is typically a relatively heavy object. If a handgun were secured to the free portion 14 of Eddy with that portion extending upwardly, the free portion would immediately swing or flop downwardly due to the structural weakness inherently created by the intentionally thinned region of material defining the "living hinge" 16. And, once swung downwardly, the free portion 14 would turn the handgun upside down whereby it could fall from the holster -- a potentially very dangerous situation. In summary, the Eddy patent is silent with regard to any teaching of a user's ability to (1) selectively dispose the device in any position other than that illustrated, or (2) selectively orient a receptacle with respect to the free portion such that its open end always faces upwardly notwithstanding whether the free portion extends upwardly or downwardly with respect to the captured portion. As discussed below, the Johanknecht patent fails to overcome this deficiency.

The Johanknecht device is a bedding blanket support having a blanket support portion 12 (FIGS. 1-4) or 52 (FIGS. 5 and 6) that is insertable between the mattress and box spring of a bed so as to define a captured portion of the blanket support when inserted between the mattress and box spring. Johanknecht further includes a pivotable leg 26 (FIGS. 1-4) or 66 (FIGS. 5 and 6).

The pivotable leg performs two functions: (1) when pivoted downwardly, it provides structural support for the blanket support portion (FIGS. 2 and 3); and (2) when pivoted upwardly, it functions in the manner of a tent pole to provide support for a spread blanket so that the blanket does not contact a user's feet (FIG. 4 and col. 3, lines 37-44 and lines 59-62).

Regardless of whether the leg 26 or 66 is upwardly or downwardly pivotable, neither it nor the blanket support portion of the Johanknecht device possess any means for connecting a receptacle to the free portion whereby a user of the caddy can orient an open end of the receptacle upwardly regardless of whether the free portion extends upwardly or downwardly with respect to the captured portion. Johanknecht simply does not contemplate any need for this desirable capability and thus, not surprisingly, does not disclose any means for achieving it.

Secondly, as defined in independent Claim 34, the first and second members of Applicant's sundries caddy are interchangeably operable as the captured portion and the free portion. That is not the case with the first and second sections 12 and 14 of the Eddy device. More particularly, FIGS. 1-3 of the Eddy patent and their attendant written description make it unmistakably clear that (1) the elongated first panel 12 is the only one of the two panels that is specifically designed and intended to be inserted between a furniture cushioning object and a cushion support structure, and (2) the short second panel 14 is the only one of the two panels that is specifically designed to connect a gun holster to the device (see the circularly arranged bores 18, holster receiving bar 22 and threaded fasteners 24 for

connecting the bar 22 to diametrically opposed pairs of the bores 18). The two panels 12, 14 are plainly not interchangeable.

The Examiner attempts to addresses this shortcoming in the Eddy patent in the sentence bridging pages 4 and 5 of the Final Office Action:

With regards to the first and second members being interchangeably operable as said captured and said free portion, the holder of Eddy is considered capable of interchangeable operation since the first member 12 has a plurality of bores 38 along the length that would allow the bar [22] received by the belt loop 28 to be connected [thereto] with suitable fasteners while the second member [14] is captured between the cushioning object and support structure.

Applicant submits that the foregoing rendition is simply not supported by the Eddy patent. First, as noted above, the Eddy patent is unambiguous in its expression that panel 12 that is the captured portion and panel 14 is the free portion. Second, the Examiner makes the baseless speculative leap that the linear spacing of bores 38 along panel 12 is the same as the diametric spacing of the bores 18 in panel 12 whereby fasteners (such as fasteners 24) may be used to connect bar 22 to panel 12 rather than panel 14. With due regard, Eddy does not even hint at this possibility.

Further, lest it become an issue, the blanket support member and pivotable leg of the blanket support of the Johanknecht device likewise are not disclosed as being interchangeable as the captured and free portions of the device.

An assertion that they are or could be interchangeable would not find any explicit, implicit or inherent basis in the Johanknecht patent. Therefore, no combination of the teachings of Johanknecht with Eddy can bridge the gap between the Eddy device and the sundries caddy prescribed by Applicant's Claim 34 in respect to this structural feature and functionality.

Furthermore, should the Examiner revert to earlier-asserted arguments dismissing Applicant's claim recitations "wherein said first and second members are interchangeably operable as said captured portion and said free portion" and "whereby a user of the caddy can orient said open end of said receptacle upwardly regardless of whether said free portion extends upwardly or downwardly with respect to said captured portion" as mere recitations with respect to the manner in which a claimed apparatus is intended to be employed which "does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation," Applicant would respectfully disagree.

The interchangeability of the first and second members called for in Claim 34 as captured and free portions is more than simply a hypothetical possibility by which Applicant's sundries caddy may be employed. It is the structure of Applicant's first and second members as embodied, for example, in FIGS. 6A, 7 and 11A and 11B, that enables those members to be interchangeable as the captured and free portions. As explained above, the disparate structural characteristics of the captured and free portions of the Eddy and Johanknecht devices effectively prevent such interchangeability. If one attempted to

do so with either apparatus, he or she would be left with a useless device.

Further, despite the fact that no combination of the teachings of Eddy and Johanknecht can produce Applicant's invention as defined in Claim 34, it appears that the Examiner may have been led to believe Applicant's invention is not obvious because of its seeming simplicity. Upon cursory review, the structure of Applicant's claimed invention may appear disarmingly simple. It is therefore understandable that one could consider Applicant's invention to be obvious in light of prior art such as Eddy and Johanknecht. However, the Examiner is reminded that it is improper to use hindsight reconstruction to reproduce piecemeal an applicant's claimed invention based on selected teachings from the prior art, especially when considering "simple" inventions. In McGinley v. Franklin Sports, Inc., the Court of Appeals for the Federal Circuit expressly warned that, for motivational purposes, where the art in question is relatively simple, particular care must be taken when considering whether to combine the references.

When the art in question is relatively simple, as is the case here, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351 (Fed. Cir. 2001).

Following this mandate, absent actual motivation in the references (which motivation is lacking in the Eddy and Johanknecht patents), it is improper to combine references merely because the claimed invention is "simple" in design. To

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do so is a legally erroneous hindsight reconstruction of an applicant's claimed invention using applicant's teachings as a guide.

Applicant thus respectfully submits that no combination of the teachings of Eddy with Johanknecht -- whether legally proper or improper -- can produce the sundries caddy specifically recited in Applicant's independent Claim 34. Therefore, withdrawal of the outstanding Section 103(a) rejection of that claim and its dependent claims 35-37 and 42 in reliance upon Eddy in combination with Johanknecht is respectfully requested.

2. Claim 47 (which indirectly depends from independent Claim 34) and independent Claims 55 and 56 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Eddy in view of Johanknecht, and further in view of U.S. Patent No. 5,946,432 to Ennis et al. ("Ennis"). Such rejection is respectfully traversed.

Each of independent Claims 34, 55 and 56 requires a sundries caddy for furniture including, *inter alia*, means for connecting a receptacle to the free portion of the caddy whereby a user of the caddy can orient an open end of a receptacle upwardly regardless of whether the free portion extends upwardly or downwardly with respect to the captured portion -- a feature that, as explained above, is unattainable through any combination of the teachings of Eddy with Johanknecht. Ennis offers nothing to overcome this fundamental deficiency of Eddy/Johanknecht tandem vis-à-vis the inventions claimed in Claims 47, 55 and 56.

The Ennis device is a baby bottle holder that uses one elastic band 38 for strapping a first leg 20 of the holder to a structure such as the handle of a baby carrier, and another elastic band 30 for strapping a baby bottle to a second leg 22 of the holder. The holder further includes handles 24 and 26 on leg 20 that are adapted to be grasped by a baby. Those handles would effectively prevent insertion of either leg 20 or 22 between a cushioning object and a cushion support structure whereby the device could assume relative inverted positions. As such, the Ennis device has no need for nor does it possess any means for connecting a receptacle to a "free" portion of the device whereby a user could orient an open end of a receptacle upwardly regardless of the position of the "free" portion relative to a "captured" portion -- because there is no portion of the Ennis device that can fairly be considered a "captured" portion as particularly claimed in Applicant's claims.

Consequently, no combination of Eddy, Johanknecht and Ennis can produce the inventions of Claims 47, 55 and 56. Therefore, any Section 103(a) rejection of those claims made in reliance upon Eddy, Johanknecht and Ennis is improper and should be withdrawn.

At this juncture, Applicant respectfully requests that prosecution be brought to a definitive conclusion. For the many reasons presented above, Applicant earnestly believes that many significant structural distinctions patentably set the instant claims apart from the teachings of references of record, whether considered individually or collectively. Accordingly, Applicant kindly urges that the claims of the present application be




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allowed at this time. To date, ten patent references in continuously evolving arrangements have been cited against Applicant's claims through the course of seven Office Actions, the sixth of which was a belated 10-way restriction requirement. Even if the Examiner continues to disagree with Applicant's position, there is nevertheless some comfort in closure. Applicant and the Examiner can agree to disagree. Thus, if the Examiner still cannot bring himself to allow all the application's elected claims at this time, Applicant kindly requests that the Examiner indicate as much in a timely Advisory Action so that the application may proceed to appeal.

Respectfully submitted,

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